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Supreme Court of the United States

OCTOBER TERM, 1959.

No. 940

CRANE PACKING COMPANY, A CORPORATION, BETH BERNICE GREEN, INDIVIDUALLY AND AS EXECUTRIX OF EARL J. BULLARD, DECEASED, AND RONALD EUGENE GREEN AND JANIS LEANORE GREEN, MINORS, BY BETH BERNICE GREEN, THEIR NEXT FRIEND,

Petitioners,

vs.

SPITFIRE TOOL & MACHINE CO., INC., A CORPORATION,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered in the above-entitled case on April 1, 1960.

OPINIONS BELOW.

The Opinion of the District Court (R. 675), reprinted in Appendix B annexed hereto, p. 26, is reported in 177 F. Supp. 927. The Opinion of the Court of Appeals, reprinted in Appendix B annexed hereto, p. 36, is reported in 125 USPQ 89.

JURISDICTION.

The judgment of the Court of Appeals was entered on April 1, 1960 (App. B, p. 36). The jurisdiction of this Court is invoked under 28 U. S. C. Section 1254(1). Federal jurisdiction of the case is based upon 28 U. S. C. Section 1338, it being an action arising under the patent laws of the United States.

QUESTIONS PRESENTED.

1. Was the law of patents so changed by the Patent Act of July 19, 1952 (Public Law 593, 82d Cong., 2d sess., ch. 950; 66 Stat. 792) as to render invalid any claim of a reissue patent not identical with a claim of the original patent unless the date of filing application for reissue, rather than the date of filing the original application, is not more than one year after the invention was patented or described in a printed publication or went into public use or on sale in this country?

2. May patent claims be declared invalid for lack of invention over the prior art, where to do so requires the selection of elements from each of a plurality of prior art patents, no one of which describes the invention, and where the prior art contains no suggestion that known elements can be combined to produce the invented machine?

STATUTE INVOLVED.

The pertinent statutory provisions and Patent Office Rules are printed in Appendix A annexed hereto, *infra*, pp. 21-25. They comprise Sections 102(b), 251 and 252 of Title 35 U. S. C. (Sections of Public Law 593, 82d Congress; 66 Stat. 792) the prior reissue statute (repealed Title 35 U. S. C. Section 64, 1946 ed., R. S. 4916); and Patent Office Rule 65 (first two sentences), and Rule 175 (Dept. of Commerce publication, September, 1955).

STATEMENT.

Facts re Question 1.

The patent in suit is for an invention in "Lapping Machines". The inventor, Earl J. Bullard, now deceased, the father or grandfather of the individual plaintiffs, made a number of inventions in "Lapping Machines" (R. 733, 761, 407) and was skilled in that art (R. 406). On March 12, 1948, he filed the application resulting in Patent No. 2,565,590, issued August 28, 1951, having ten claims (R. 714, 715).

On March 12, 1948, the machine described in the patent was first sold and entered into public use (R. 659).

On June 25, 1953, less than two years after the issue date of Patent No. 2,565,590, application was filed to correct that patent by reissue thereof. The petition was granted and Patent Re. 23,937 (R. 695) was issued on February 8, 1955 for the unexpired remainder of the term of Patent No. 2,565,590, that is until August 28, 1968.

The reissue patent contains fourteen claims (R. 703, 704). The first ten are identical with Claims 1-10 of the original patent, and Claims 11-14 are not identical with any original claim.

The machine described in the patent and the methods claimed therein were in public use for more than one year before the original patent issued on August 28, 1951, and consequently for more than one year before the application for reissue was or could have been filed. There was no public use, however, more than one year before the original application was filed.

The original patent No. 2,565,590 was printed, issued and published on August 28, 1951, more than one year, but less than two years, before the application for reissue was filed.

As to Claims 11-14 inclusive, the Court of Appeals held. (App. B, pp. 41-43) each to be invalid *only* because machines embodying or operating to carry out the invention claimed in such claims were in public use or on sale for more than one year prior to the date, June 25, 1953, when application was made to reissue Patent No. 2,565,590. There is no contention that there was any public use or sale affecting validity of the original patent. The Court of Appeals based this conclusion completely upon its decision that the third paragraph of 15 U. S. C. Section 251 which states that:

> "The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent."

is "an entirely new provision added by the Patent Act of 1952" and that it has the effect of making the provisions of 35 U. S. C. Section 102(b) applicable to all claims of a reissue patent which are not "identical" with a claim of the original patent, thus invalidating all such claims in a reissue patent where the invention claimed was in public use or on sale, or described in a printed publication for more than one year prior to the date of application for reissue.

The Patent Act of 1952, codifying law established by the Courts, also specifically provides in Section 251 that:

> "No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."

but places no time limitations for filing applications for reissue not enlarging the scope of the claims.

In any case, the reissue patent in suit was applied for within two years from the grant of the original patent.

The Annual Reports of the Commissioner of Patents regularly published by the Department of Commerce disclose that since the Patent Act of 1952 became effective and through the date of the Court of Appeals' opinion herein 1146 reissue patents have been issued. Of these reissue patents, 480, or 41.9%, were applied for more than one year after the original patent had issued and become a publication, and all of them have claims not identical to any claim of their original patent.

Facts re Question 2.

On March 12, 1948, plaintiff Crane Packing Company became exclusive licensee of Bullard under a written license agreement (R. 406) which is still in effect. Through March, 1958 said licensee made gross sales of licensed "Lapmaster" machines in excess of $7,750,000.00 (R. 457) and had paid to Mr. Bullard and his heirs $299,871.12 in license and royalty fees (R. 456). Non-exclusive licenses to use machines embodying the invention had also been granted to five additional companies (R. 281).

The "Lapmaster" machines sold under the license by Crane Packing Company had become widely approved by industry prior to this action (R. 541-566) and had become the standard specified in government requests for bids by the Ordnance and Signal Corps (R. 439).

The machines made under the patent are described in Crane Packing Company's brochure (R. 523-540).

The Bullard patent is briefly described in the Court of Appeals' opinion (App. B, pages 37, 38). The Court describes the general nature of a lapping machine, the problem of maintaining a "true" surface on the lap plate which carries the abrading material which accomplishes lapping of the work piece articles and also wears and abrades the surface of the lap plate while such work is being accom-

plished. The opinion also describes the invention of the patent whereby a simple adjustment of a wear ring radially upon the lap inwardly and outwardly permits the machine automatically to maintain a flat, a convex, or a concave surface on the lap plate to produce the desired flat, concave or convex surface on the work pieces being lapped while the manufacturing operation is in progress and without shutdowns for dressing or changing the lap plate as required by prior art machines.

Additionally, however, it should be stated that lapping is a surface finishing and shaping operation the accuracy of which is measured in millionths of an inch (R. 293), a quantity too small to be seen or measured by ordinary micrometers or other shop tools and hence requiring the use of special optical devices known as "optical flats" for its measurement (R. 537). Although the prior art considered by the Patent Office and cited in the Court of Appeals decision showed a lapping machine (Desenberg) which simultaneously lapped articles and was "self-truing", the method and apparatus there disclosed required the same accuracy in the support and adjusting means for its truing device and for its article positioning device as it sought to achieve in the articles (R. 754). If used for the same purpose as the Bullard invention it would require that both the article positioning device and the truing device be supported in bearings that ran "true" to an accuracy of millionths of an inch, which is an impossibility. The same prior art also required, insofar as it related to lapping machines, three different machines for flat, convex and concave surface lapping (R. 749, 751). There is no evidence that this prior art machine had any commercial use.

The method and machine described in the Bullard patent achieves the desired accuracy of millionths of an inch with apparatus built only to average, everyday machining ac-

curacies and with adjustments in the truing tool as coarse as a quarter of an inch to effect a change in lap surface contour of millionths of an inch (R. 293). Unlike Desenberg, in Bullard no separate article positioning device is needed but the articles are simply placed into ring-shaped truing tools (*i.e.*, "wear rings") so that the latter conveniently serve as article positioning devices as well as truing devices. In Bullard the same basic machine can be used to lap flat, convex and concave surfaces.

The achievement of accuracy in millionths of an inch with equipment built to an accuracy of only thousandths of an inch, and with adjustments as coarse as a quarter of an inch was not believable by those skilled in the art, but when demonstrated, resulted in complete and continuing acceptance of "Lapmaster" machines by workmen familiar with the art of lapping (R. 289, 291).

In 1956, defendant commenced to manufacture lapping machines called "Gyro-Matic Model 24" (R. 216). This machine was one sold to the government by defendant and described by defendant as the "equal" of the Crane machine (R. 439).

This action was filed January 14, 1958 (R. 2) and defendant was charged with infringement of Claims 1-4 inclusive, and 9-14 inclusive of Patent Re. 23,937.

The District Court held each of the patent claims in issue to be invalid and dismissed the action (R. 684). It did not pass upon the issue of infringement.

The Court of Appeals likewise held each of the claims in issue to be invalid, did not pass upon the issue of infringement, and affirmed the judgment (App. B, p. 43).

Claims 1-4, 9 and 10 were all held by the Court of Appeals to be invalid as obvious combinations of elements from the prior art Desenberg patent No. 2,352,146, Hoke patent No. 1,536,714, Morton patent No. 1,691,120, and Missler (German) patent No. 345,443.

It was held that although Bullard's use of these features resulted in improvements advantageous in industry, such did not amount to invention in view of such prior art (App. B, p. 41).

With respect to this prior art, the Court of Appeals erroneously believed and stated (App. B, p. 41) that none except Desenberg "was before the Patent Office" and that therefore the presumption of validity was not present. Actually, however, all of the prior art patents referred to were considered by the Patent Office, with the single exception of Morton No. 1,691,120, and they are listed at the end of the Bullard patent (R. 704). The Hoke patent listed by the Commissioner has a different number than that cited in the Court of Appeals' opinion but has substantially the same disclosure (R. 717 and 721).

The Morton patent not listed by the Commissioner is not for a lapping machine but shows a rough grinding wheel, the circular object thereon being the article being ground (a piston ring) which is not a part of the machine (R. 727).

REASONS FOR GRANTING THE WRIT.

1. The Court of Appeals decision holds that the Patent Act of 1952 made an important change in the patent law relating to reissue patents so that the statutory bar provisions of Section 102(b), to the effect that a patent is invalid if the invention was described in a printed publication or in public use or on sale in this country more than one year prior to the application for patent, are incorporated by reference into Section 251 of the Act and render invalid every reissue claim not identical with a claim of the original patent unless the application for reissue is filed before such one-year period has expired. Such decision decides an important question of federal law that has not been decided by this or any other federal court,

and in a manner and to a result directly contrary to earlier decisions uniformly holding prior to the Patent Act of 1952 that identical provisions in the prior patent statutes setting up a statutory bar as the result of publication, use or sale applied only as of the date of the original application for a patent and not as of the date of application for reissue thereof.

This interpretation of the Patent Act of 1952 by the Court of Appeals for the Seventh Circuit should be reviewed by this Court for the following reasons:

A. The decision, if correct, renders invalid substantially every reissue patent claim, not identical to an original claim, granted since January 1, 1953. A publication describing an invention is just as much a bar to a valid patent under Section 102(b) as is a public use or sale. A patent is printed and published, sent out for distribution all over the world, and described in the Patent Office Official Gazette on the same day that it issues. Under the Court of Appeals' decision, every patent becomes a bar to any corrective claims in a reissue thereof unless the reissue application is filed within one year after the original grant. The official reports of the Commissioner of Patents disclose that more than 40% of all reissue patents granted since January 1, 1953 were applied for more than one year after their parent patents were issued. If an invention has been of sufficient merit to have gone into commercial use while the original application was pending, no reissue to correct a claim of a defective patent could even be filed in most instances. As to the patent in suit, the first machine was sold on the very day the original patent application was filed (R. 659). That application was pending for three years and five months before the patent issued (R. 711). This was a normal period of pendency before issue (See patents at R. 723, 733, 749, 761, 773).

If the Court of Appeals' decision is sound, the right to correct the patent by reissue was barred long before the original patent issued.

B. The decision by the Court of Appeals nullifies the provision in the last paragraph of Section 251 of the same act, which expressly permits a two-year period after grant of a patent in which to apply for a reissue thereof if claims enlarging the scope of the original claims are sought. Any claim which is narrowed or enlarged cannot be identical to an original claim, and would therefore be barred under the decision no later than one year after the original grant. The Court's opinion statement that "a reissue application enlarging claims may be filed within two years from the grant of the original patent" but that "it is, nevertheless, subject to the conditions proscribed by § 102(b)" (App. B, p. 43) is completely inconsistent and without meaning, and ignores the effect of publication set forth in said section.

C. The decision holds that the Patent Act of 1952 made a sweeping and vital change in the law relative to reissues as it had been interpreted and applied by the courts for more than a century. Under the prior reissue statutes, it had been uniformly held since 1832 that for the purpose of applying the bar of prior public use or sale, a reissue patent was deemed appended to and related back to the date of filing of the application for the original patent.

In *Grant* v. *Raymond*, 6 Peters 218, 244 (1832), this Court rejected a contention that a reissue patent was to be considered as a new patent having a filing date of the application for reissue, and said:

> "It has been also argued that the new patent must issue on the new specification and on the application which accompanies it. Consequently, it will not be true that the machine was 'not known or used before the application.'

> But the new patent, and the proceedings upon which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application; and, if the new patent is valid, the law must be considered as satisfied if the machine was not known or used before that application."

To the same effect, see *Shaw* v. *Cooper* (1833), 7 Pet. 292, 315, 316. *Cf. Garneau* v. *Dozier, et al.*, 102 U. S. 230, 234.

That rule has been followed by the lower courts and was succinctly expressed in *Shaw* v. *Colwell Lead Co.*, 11 Fed. 711, 715 (C. C. N. Y.—1882) as follows:

> "And further, the reissued patent is not a new patent, but is only an amended form of an old one, and the application for the reissue is not an application for a patent, but is an application for an amendment of one; and that cannot be such an application as is referred to as being necessary to be made before two years of public use shall have been had."

The rule has been followed by the Commissioner of Patents, *Carroll* v. *Morse*, 9 O. G. 453, 454 (1876); and has been uniformly recognized by the text-writers, *Walker on Patents*, Deller Ed. (1937), pp. 1389-1390; *Patent Soliciting and Examining*, Glascock and Stringham (1934), p. 578; and *Robinson on Patents* (1890), Vol. II, Sec. 667, n. 2, p. 341; Sec. 703, p. 428, and Sec. 708, p. 434.

The pertinent rules of practice of the Patent Office (App. A, p. 24) expressly provide in Rule 65 the requirements of an oath which must be subscribed by the inventor as a part of every "original application". Rule 175 (App. A, pp. 24, 25) expressly sets forth the requirements of an oath to be made by the applicant for reissue of a patent, but does not require the negation of conditions which would create a statutory bar under Section 102(b) as is required under Rule 65 for original applications. If the Court of

Appeals' decision is correct, then the form of oath prescribed by the rules for a reissue application have been wrong since January 1, 1953 and must be changed; and no application for reissue can be accepted if the reissue correction sought is either to amend the claims or add additional claims whether broader or narrower than the original claims, and the application is made more than one year after the original grant or a public use or sale.

The statute, Section 251, expressly provides as a ground for reissue a defect in the original patent "by reason of the patentee claiming more or less than he had a right to claim", and virtually every reissue patent contains claims not "identical" to a claim of the original grant. This statutory provision becomes meaningless under the Court of Appeals' decision unless the patent has had no commercial use and has not been issued for as long as one year.

D. The decision of the Court of Appeals is in conflict with long established rules of statutory construction laid down by the decisions of this Court, that it is not lightly to be assumed that Congress intended to depart from long established policy, *Robertson* v. *N. L. R. B.*, 268 U. S. 619, 627 (1924); that a restrictive meaning for what may appear to be general language must be given where a consideration of the legislation in its entirety and its history so indicate, *Offutt Housing Co.* v. *Sarpy County*, 351 U. S. 253, 260 (1955); *U. S.* v. *Witkovich*, 353 U. S. 194, 199 (1956); and the well-established rule that where legislation affecting a subject matter has undergone revision and consolidation by codification, the revised sections will be presumed to bear the same meaning as the original sections unless legislative intent to change meaning is clearly and indubitably manifested. *Anderson* v. *Pacific Coast Steamship Co.*, 225 U. S. 187, 199 (1911); *McDonald* v. *Hovey, et al.*, 110 U. S. 619, 629 (1883); *U. S.* v. *Ryder*, 110 U. S. 729, 739, 740 (1883).

The interpretation of Section 251 by the Court of Appeals in this case is also in conflict with the decisions of this Court holding that statutes shall be construed in such manner as to give effect to every word and provision, *Ex Parte Public National Bank of New York*, 278 U. S. 101, 104 (1928); *Peck* v. *Jenness*, 48 U. S. (7 How.) 320, 325; and *Mastro Plastics Corp.* v. *N. L. R. B.*, 350 U. S. 270, 285, 298 (1955); and that in cases of seeming conflict in provisions of a statute, the construction should be that both provisions, if possible, may stand, and repugnancy should, if possible, be avoided, *U. S.* v. *Moore*, 95 U. S. 760, 763 (1877); *Lamp Chimney Co.* v. *Brass & Copper Co.*, 91 U. S. 656, 663 (1875).

The opinion of the Court of Appeals violates those canons of statutory construction in at least two respects.

First, incorporating Section 102(b) into Section 251 by reference, as the Court of Appeals says the third paragraph of Section 251 requires, is to state that claims added or amended in a reissue patent will be given effective date only as of the date of the application for reissue. However, this creates a conflict with Section 252 which contains the following provision:

> "* * * Every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising as if the same had been originally granted in such amended form * * *."

This latter language has been a part of the reissue statute as R. S. 4916 (U. S. C. A. Repealed Title 35, Sec. 64) since the Act of July 8, 1870, 16 Stat. 205, with but a slight amendment by the Act of May 24, 1928, 45 Stat. 732.

Second, the fourth paragraph of 35 U. S. C. Sec. 251 is new in the Patent Act of 1952 and provides:

> "No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."

If, as the Court of Appeals holds, Section 102(b) of Title 35 is to be incorporated into Section 251, then necessarily the *entire* Section 102(b) is incorporated, including the bar by description in a printed publication as well as by public use or sale.

Since each patent is published in the Official Gazette of the United States Patent Office on the date it is issued, and the Commissioner of Patents supplies printed copies of the specifications and drawings to public libraries in the United States (pursuant to 35 U. S. C., Sec. 11), the issuance and consequent immediate publication of the original patent would itself become a statutory bar to applying for a reissue thereof with amended or enlarged claims one year thereafter. This result is clearly repugnant to the intent of Congress evidenced by the fourth paragraph of Section 251 allowing two years from the grant of the original patent within which to apply for reissue with enlarged claims.

E. The Court of Appeals' decision interprets the 1952 Act, in the sections in question, as to effect a major change in the substantive law relating to reissue patents. Congress, however, indicated no such intent.

That Congress did not contemplate any major change of substantive law is apparent from the report of the Senate Committee on the Judiciary, Senate Report No. 1979, June 27, 1952 (which repeats in substance House Report No. 1923 of May 12, 1952) where it is stated, 2 U. S. Code Congressional and Administrative News (1952), 2400, 2401:

> "Sections 251 and 252 are a development of the present statute relating to what are called reissues. Under certain circumstances the patentee may obtain a new patent to replace the old one to correct certain kinds of defects that he may have discovered in the patent. These two sections together replace the present one, make a number of clarifications and a few additions in further development of the subject."

That Congress by the third paragraph of Sec. 251 of the Patent Act of 1952 had in mind only formal or procedural matters and not changes in the substantive law relating to reissues seems also clear from the language used in that paragraph. There, Congress said that

> "The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent * * *."

Congress did not say, as it could have said if such was its intent, that all of the provisions of the Patent Act of 1952 relating to patents were applicable to applications for reissue, but referred only to the provisions relating to *applications* for patent. Section 102(b) of the Act does not relate to applications for patents but sets forth the substantive law as to the conditions for patentability of an invention. The sections of the Patent Act of 1952 which relate to applications for patents are principally contained in Chapter 11 of the Act but not in Chapter 10 wherein Section 102(b) is found.

2. In holding Claims 1 to 4, inclusive, and 9 and 10 invalid on the ground that they are non-inventive in that they define combinations of elements which may separately be found in a plurality of prior art patents, although there is no suggestion in any of the references that such a combination be made, the Court of Appeals adopted a standard of invention impossibly severe and contrary to the rules for testing inventive improvement as set forth in the decisions of this Court and uniformly followed in every Circuit, and heretofore in the Seventh Circuit. Such a departure from established standards to strike down six claims of the Bullard patent, especially in the light of the tribute paid thereto by the licensees and the trade, should be corrected. The Seventh Circuit, including as it does the great manufacturing centers in Illinois, Wisconsin and Indiana, is a very important area from the standpoint of

inventive creation and development directly bearing upon industrial advancement, and the economic safety of the nation. To strike down patents by a post-invention selection of the elements of a machine from obscure prior art which failed to inform those skilled in the art how to practice the principles disclosed in the Bullard patent, and defined in Claims 1-4, 9 and 10, poses a serious threat to the incentive to invent and improve, which this Court should correct.

The Bullard invention defined in Claims 1-4, 9 and 10 is not suggested in the patents cited by the Court of Appeals. What that Court has done in this case is to find a radial adjustment in one patent (Missler), a workholder in a second patent (Hoke), a wear ring in still a third (Desenberg), and erroneously looked at a patent drawing in still another patent (Morton) to find what looks like a loosely resting wear ring but actually is a piston ring to be ground, and then to say that to put those together was merely an obvious combination of known elements, although there was no suggestion to do so in the prior art.

Such a standard of invention is contrary to the accepted standard elsewhere applied pursuant to the decisions of this Court. It is so directly contrary to the standard applied by the Patent Office following this Court's decisions as to make the question of invention in the Seventh Circuit thoroughly unsettled and chaotic. In citing this Court's decision in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, as authority for such a standard, the Court of Appeals shows a lack of understanding of the limits of the *A. & P.* decision which should be corrected.

A. The Court of Appeals' decision holding invalid Claims 1-4, 9 and 10 avoids the new statutory requirement that "A patent shall be presumed valid" (Sec. 282), by erroneously stating that "Of the prior art relied upon

by defendant only Desenberg was before the Patent Office." This statement reflects a serious error in the Court's consideration of the record showing that all of the references except one, the Morton patent (R. 727), were expressly considered by the Patent Office and are listed on the patent (R. 704). The Hoke reference mentioned in the Court's opinion is Patent No. 1,536,714 whereas the Hoke reference listed by the Patent Office is Patent No. 1,486,345 to the same inventor. Both patents are, however, substantially the same disclosure by the same Mr. Hoke, and have closely similar drawings. There are no relevant differences in disclosure between the two Hoke patents (R. 717 and R. 721) insofar as either has any pertinency to the Bullard patent. The Morton patent (R. 727) was not listed by the Patent Office for obviously good reasons. It does not disclose a lapping machine but merely a horizontal grinding wheel. The circular object appearing in the drawing as resting on the wheel surface is not a "truing" means or wear ring but is the work piece itself which has the effect of wearing the surface of the wheel out of "true", not to maintain its "trueness". This the Court of Appeals obviously did not understand. The premise therefore upon which the Court of Appeals avoids the presumption of validity is thoroughly erroneous. Such a mistake fails to apply one of the most important of the statutory requirements in favor of a patent.

B. A basic principle of patent law which has been established and followed uniformly for many years was early expressed by this Court in *Bates* v. *Coe*, 98 U. S. 31, 48, as follows:

> "Where the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine,

and another part in another prior exhibit, and still another part in the third one, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement."

The Patent Office tribunals have repeatedly and regularly followed the rule set forth in *Bates* v. *Coe* and the law is stated in numerous decisions of the Court of Customs and Patent Appeals that an application may not be rejected upon the basis of a plurality of references, none of which discloses the combination of elements, even though all taken together may show the separate elements involved, unless there was a suggestion in the prior art for doing what the applicant has done. The test as stated in *Application of Shaffer*, 229 F. 2d 476, 479 (C. C. P. A.—1956) is:

> "namely, whether the prior art suggests doing what an applicant has done." * * * (Citing authorities.)
>
> "The foregoing cases, in our opinion, stand for the proposition that it is not enough for a valid rejection to view the prior art in retrospect once an applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an applicant has done. If the art did not do so, the references may have been improperly combined."

When Congress codified the law of patents in the Patent Act of 1952, it provided in Section 103 that a patent might be invalid on the basis of prior art

> "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. * * *"

The Court of Appeals in finding Claims 1-4, 9 and 10 invalid as combining elements from each of four separate prior art patents, there being no suggestion in any of the

references that such elements should or could be combined to produce the Bullard invention, set as a test of patentability a standard contrary to the decision in *Bates* v. *Coe* and the many subsequent decisions following that rule, including the established practice in the Patent Office, and contrary to the provisions enacted by Congress in the Patent Act of 1952. The result of the decision in that regard is to create a false standard for testing invention, a standard which would defeat the great majority of important inventions and one which will so strike down patents as to discourage seriously the exchange of information to the public for the grant of Letters Patent as contemplated by the patent laws. Such decision should be reviewed and corrected.

CONCLUSION.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

WARREN C. HORTON,

CHARLES F. VOYTECH,

JOHN R. NICHOLSON,

CHARLES M. NISEN,

Counsel for Petitioners.

APPENDIX A.

Title 35 U. S. C.

§ 102. *Conditions for patentability.*

A person shall be entitled to a patent unless—

* * * * *

(b) the invention was patented or described in a printed publication in this or a foregin country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

* * * * *

§ 251. *Reissue of defective patents.*

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and

sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

§252. *Effect of reissue.*

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was

made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

§ 64. *Reissue of defective patents; patents for separate parts.* (REPEALED.)

Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation

in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. R. S. § 4916; May 24, 1928, c. 730, 45 Stat. 732.

Patent Office Rule 65.

(First Two Sentences.)

65. *Oath of applicant.* (a) The applicant, if the inventor, must make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the process, machine, manufacture, composition of matter, or improvement thereof, for which he solicits a patent; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides, and whether he is a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state under oath that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States more than one year prior to his application, or patented or described in any printed publication in any country before his invention or more than one year prior to his application, or patented in any foreign country prior to the date of his application on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in this country.

Patent Office Rule 175.

175. *Reissue oath.* Applicants for reissue, in addition to complying with the requirements of the first sentence of rule 65, must also file with their applications a statement under oath as follows:

(a) That applicant verily believes the original patent to be wholly or partly inoperative or invalid, and the reasons why.

(b) When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly specifying such defects.

(c) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

(d) Particularly specifying the errors relied upon, and how they arose or occurred.

(e) That said errors arose "without any deceptive intention" on the part of the applicant.

Corroborating affidavits of others may be filed and the examiner may, in any case, require additional information or affidavits concerning the application for reissue and its object.

APPENDIX B.

IN THE UNITED STATES DISTRICT COURT
For the Northern District of Illinois,
Eastern Division.

Crane Packing Company, a corporation, and Beth Bernice Green, individually and as executrix of Earl J. Bullard, deceased, *Plaintiffs,*	No. 58 C 71.
vs.	
Spitfire Tool & Machine Co., Inc., a corporation, *Defendant.*	

FINDINGS OF FACT, CONCLUSIONS OF LAW AND JUDGMENT.

CAMPBELL, *Chief Judge.*

Plaintiffs bring this action against defendant for infringement of Claims 1 to 4, inclusive, and 9 to 14, inclusive, of United States Letters Patent No. Re. 23,937, issued to Earl J. Bullard on February 8, 1955, on a lapping machine. Defendant denies infringement of the aforesaid patent, asserts that it is invalid and by way of counterclaim, seeks a declaratory judgment with respect to the validity and infringement of the aforesaid patent.

A lapping machine is a particular type of fine grinding machine designed and intended to impart to a work piece a finely finished surface. It comprises one or more lapping

surfaces, each of which is known as a lap plate, generally made of cast-iron, upon which an abrasive compound is applied. The work piece or article to be lapped is then moved over the surface of the lap plate until the desired surface is obtained on the work piece, or as nearly to the desired surface as the capabilities of the machine permit. The lapping of a work piece causes wear and abrasion not only on the surface of the work piece but also on the surface of the lap, or lap plate, resulting in the lap surface becoming grooved or roughened, and losing its "true" or desired surface. When this occurs the lap surface must be restored to its desired or true condition.

The patent in suit discloses maintenance of a true flat surface on the lap plate, or changing it from a convex to a flat, or to a concave surface, and vice-versa. A wear ring (or a plurality thereof) is placed on the surface of an annular lap plate having an inner edge around a central cavity, and an outer edge. The wear ring is adapted to hold work pieces which may be placed within the ring in a work holder. Usually the work is maintained in place within the ring by having placed over it within the ring a felt pad and a pressure plate. The ring is then maintained upon the lap surface by adjustable pivot means or bearings which are adjustable so that the ring may be adjusted radially on the surface of the lap plate. As the lap plate is rotated, the frictional relationship between it and the lap ring causes the latter to rotate but not to travel with the lap plate surface since the lap ring is restrained from such travel by the adjustable pivot. The ring, therefore, rotates on the lap plate and by frictional relationship also rotates the pieces within the ring, that is, the work holder, the work therein, the felt pad and the pressure plate, if present. In its rotation on the lap plate, and the simultaneous rotation of the plate, the wear ring of the patent in suit wears away the surface of the lap and maintains a flat

surface thereon both truing the plate and holding the work at the same time. By moving the wear ring of the patent in suit radially between the outer edge and the inner edge of the lap plate, the pressure of the ring and of portions thereof on the lap plate will be made to vary. As a result, the lap plate may be caused to have a convex surface, a concave surface or a flat surface as desired, and grooves in the lap plate are removed as they may be formed by pressure of the work pieces against the abrasive material on the lap plate.

Reissue Claims 1 to 4, inclusive, and Claims 9 and 10 are all claims of patent No. 2,565,590 and remain unchanged in the reissue patent. Substantially, they cover an apparatus for forming a true surface of predetermined contour upon an article. Reissue Claims 11 to 14, inclusive, are added as a result of the reissue patent. Reissue Claims 11 and 12 cover the method of changing the contour of the surface of an annular lap to cause it to conform to a standard surface whether that standard surface be flat, concave or convex. Reissue Claims 13 and 14 cover an apparatus for forming a plane surface on an article.

Defendant, by its answer and counterclaim as amended, contends that:

(1) Claims 1 to 4, 9 and 10 are invalid as defining an aggregation;

(2) Claims 11 to 14, inclusive, are invalid because of public use and sale;

(3) Claims 1 to 4, 9 and 10 are invalid in view of certain prior art patents;

(4) Claims 11 to 14 are anticipated by certain prior art patents;

(5) Claims 1 to 4 and 9 to 14, inclusive, are invalid on the grounds of indefiniteness;

(6) Claims 11 to 14, inclusive, are invalid as not coving the invention intended to be covered by Bullard in his original patent No. 2,565,590;

(7) The reissue patent was wrongfully issued;

(8) The claims in issue are invalid because the patentee failed to comply with Sec. 112 of the 1952 Patent Act;

(9) Claims 1 to 4 and 9 to 14, inclusive, are not infringed by defendant's device.

I now consider defendant's first contention. It is well established law that "the mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that heretofore performed or produced by them is not patentable invention." *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 151; *Anderson Company* v. *Sears Roebuck & Co.*, 7 Cir., (No. 12459, April 14, 1959); *Pleatmaster, Inc.* v. *J. L. Golding Mfg. Co.*, 7 Cir., 240 F. 2d 894, 899. Conversely, "a novel combination of old elements which so cooperate with each other so as to produce a new and useful result or a substantial increase in efficiency is patentable." *Anderson Co.* v. *Sears Roebuck & Co., supra; Weller Manufacturing Co.* v. *Wen Products, Inc.*, 7 Cir. 231 F. 2d 795, 798. In *Anderson Co.* v. *Sears Roebuck & Co., supra*, the Court further explains the rule by pointing out that it is not patentable invention "where the result obtained was obvious, expected, old or merely an improvement over an old result."

A comparison of the reissue patent in suit, as shown in Fig. 1, with Morton patent 1,691,120, as shown in Fig. 5, in light of Hoke patent 1,536,714, as shown in Fig. 1, is as follows:

As shown in the Morton patent, 3 is a rotatable lap comparable to the lap 1 of the Bullard device. 1 is a means in the form of a ring comparable to the ring 61 of the Bullard device which maintains the surface of the lap in condition and which ring 1 of the Morton, like the Bullard ring 61, is rotated about its own center and also relative to the lap.

While Morton does not show a work holder such as the Bullard work holder 62 within the ring 1, such a work holder is shown in the Hoke patent at 35. It appears that the work holder 35 of Hoke can be bodily lifted out of the Hoke device and placed within the ring 1 of the Morton device with the apparent result that the work holder 35 of Hoke would function substantially in the same manner as it did in the assembly of the Hoke device and in the same manner as the Bullard work holder 62.

A comparison of the reissue patent in suit, as shown in Fig. 1, with Desenberg patent No. 2,352,146, as shown in Fig. 1, and Hoke patent No. 1,536,714, as shown in Fig. 1, is as follows:

The device of the Desenberg patent is a lapping or grinding machine with a rotatable lap 17 comparable to the lap 1 of the Bullard device. 19 is a work holder comparable to the work holder 62 of Bullard for holding the article on the lap. Means in the form of a ring 32 maintains the surface of the lap of Desenberg in condition and is comparable to the ring 61 of Bullard. The ring 32 of Desenberg has a pivoted support 41. While the ring 32 does not encircle the work holder 19 nor contact the same, the Hoke patent discloses a rotatable and oscillatory ring 20 within which a work holder 35 is mounted and contacts the ring and is caused to rotate by rotation and oscillation of the ring 20 and by frictional engagement with the opposite laps 10 and 13, as shown in Fig. 2.

The German patent No. 345,443 has a lap (a) like the lap 1 of the reissue patent including inner and outer peripheries. The constraining means (work holders c) are adjustably carried by the rods (K). In the German patent it is stated: "The holding means are also here again disposed offset, so that the work-pieces interchangeably pass along over inner and outer rims of the grinding ring in

order to insure continuously the evenness of the grinding ring."

In light of the above prior art, it appears that the patentee Bullard has combined the lap, the work holder, the rotating means, the truing ring, and the pivoted support of Desenberg with the work holder 35 and the spider 20 of Hoke and the constraining or holding means of either Morton or the German patent. It also appears from the evidence that the work pieces to be lapped can be contained within the wear ring with or without a work holder, or can be held on the lap outside of the wear ring with the same function and result. Customers often omit the work holder, the pressure plate and felt pads when using the apparatus of reissue Claims 1 to 4, 9 and 10.

I hold the reissue Claims 1 to 4, 9 and 10 to be a mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that heretofore performed or produced by them. The result obtained was obvious, expected and merely an improvement over an old result. As such it is not patentable invention.

I now consider defendant's second contention.

Title 35 U. S. C. Sec. 102 (b) provides that a patent shall issue unless the invention "... was ... in public use or on sale in this country, more than one year prior to the date of the application for the patent ..." Title 35 U. S. C. Sec. 251 provides in part as follows:

> "The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent . : ."
>
> "No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."

I hold that the two-year limitation contained in the fourth

paragraph of Section 251, as quoted above, merely limits the time within which a reissue patent may be filed for the purpose of enlarging the scope of the claims of the original patent. It does not abridge or conflict with either Section 102 (b) or the third paragraph of Section 251 as quoted above.

Title 35 U. S. C. Sec. 252 provides that a

> "... reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent."

It follows from the above Sections that a reissue patent has to relate back to the filing date of the application for the original patent in order to avoid the consequence of public use and sale. To relate back to the filing date of the application for the original patent, the reissue patent must constitute a continuation of the original patent. In order for the reissue patent to be a continuation of the original patent and thereby relate back to the filing date of the application for the original patent, the claims of the reissue patent must be identical to the claims of the original patent.

I hold that reissue Claims 11 to 14, inclusive, are not identical with any claim of the original patent; that they are not a continuation of the application on which the original patent issued; that they do not relate back to the filing date of the application for the original patent but are to be computed from July 25, 1953, on the question of public use and sale.

Since the evidence demonstrates that the device of reissue Claims 11 to 14, inclusive, was on sale and in use more than one year prior to July 25, 1953, I hold reissue Claims 11 to 14, inclusive to be invalid.

As to defendant's third contention, I hold Claims 1 to 4,

9 and 10 invalid in view of Hoke, patent No. 1,536,714; Morton, patent No. 1,691,120; Desenberg, patent No. 2,352,146; German (Missler), patent No. 345,443 which have been described in regard to defendant's first contention. The foregoing examples of prior art and evidence concerning devices in commercial use sustain the conclusion that one having ordinary skill in the art would find the claimed invention obvious. *Enterprise Railway Equipment Co.* v. *Keystone Railway Equipment Co.*, 7 Cir., (No. 12508, May 20, 1959). These features had been employed in other similar devices. Their adaption by plaintiff resulted in an improvement but represents no more ingenuity than the work of a mechanic skilled in the art. There are no unusual or surprising consequences from the unification of the elements here concerned. *Senco Products, Inc.* v. *Fastener Corp. & Duo-Fast Co.*, 7 Cir., (No. 12548, July 8, 1959).

I now consider defendant's fourth contention.

Since, as I pointed out in defendant's second contention, the reissue patent, as to Claims 11 to 14, speaks from the filing date, June 25, 1953, the Roshong patent No. 2,627,144 is a valid reference under the defense of anticipation because it was issued February 3, 1953, on an application filed March 21, 1950.

A comparison of the reissue patent, as shown in Figs. 1 and 4 and the Roshong patent, as shown in Fig. 1, is as follows:

Roshong shows a lap 12 having inside and outside peripheral edges rotatable about a fixed axis, a dressing tool 16 which is positioned to rest upon the lap surface with the outside edge of the tool extending beyond the peripheral edges of the lap surface to provide an overhang of both the inside and outside peripheral edges. There is a means 18 and its asspciated parts for constraining the

dressing tool while resting on the lap surface with its axis substantially parallel to the axis of rotation of the lap surface, but free to move its axis through an angle so that the wear face may tend to conform with the lap surface when the latter is worn out of flatness. Such constraining means 18 and its associated parts prevent movement of the tool bodily from the surface while the lap is rotated and permit shifting of the dressing tool to vary the relative amount of overhang of the ring 16 with respect to the peripheral edges. I hold that Roshong discloses an apparatus capable of practicing the method set forth in Claims 11 and 12 as well as in apparatus which responds to Claims 13 and 14.

I hold Claims 11 to 14, inclusive, invalid for lack of invention and anticipation in view of Roshong patent No. 2,627,144; Morton patent No. 1,691,120; Desenberg patent No. 2,532,146. *Senco Products, Inc.* v. *Fastener Corp. & Duo-Fast Co., supra.*

As to defendant's fifth contention, I hold that Claims 1 to 4 and 9 to 14, inclusive, are not invalid on grounds of indefiniteness.

As to defendant's sixth contention, I hold that reissue Claims 11 to 14, inclusive, are not invalid as not covering the invention intended to be covered by Bullard in his original patent No. 2,565,590.

As to defendant's seventh contention, I hold that the reissue patent was not wrongfully issued.

As to defendant's eighth contention, I told that patentee Bullard did comply with Title 35 U. S. C. Sec. 112 and that the claims in issue are not invalid upon this ground.

I am aware of the presumption of validity which attaches to a patent, Title 35 U. S. C. Sec. 282, but conclude in this case that such presumption "was overcome by clear and convincing evidence on the part of the defendants

. . . ." *Century Industries* v. *Wieboldt Stores*, 7 Cir., (No. 12423, March 3, 1959). The commercial success of plaintiff's commercial device will not make patentability where invention is lacking. *Great Atlantic and Pacific Tea Co.* v. *Supermarket Corp., supra.*

As I have previously pointed out in the consideration of the first four contentions of defendant, I hold reissue Claims 1 to 4, inclusive, and 9 to 14, inclusive, invalid. Though plaintiff's device represents an improvement, it is clear that from one or more related prior art patents, one having ordinary skill in the art would find the claimed invention obvious. *Senco Products, Inc.* v. *Fastener Corporation & Duo-Fast Co., supra.*

Since I hold the reissue claims in suit invalid, I do not reach the question of infringement. *Enterprise Railway Equipment Co.* v. *Keystone Railway Equipment Co., supra.*

It is accordingly ordered, adjudged and decreed, for the reasons stated, that reissue Claims 1 to 4, inclusive, and 9 to 14, inclusive, of Bullard patent No. Re. 23,937, are invalid. Defendant's counterclaim for injunction is denied. The cause is hereby dismissed at plaintiff's costs.

WILLIAM J. CAMPBELL,
Chief Judge.

DATED: July 30, 1959.

IN THE UNITED STATES COURT OF APPEALS.

For the Seventh Circuit.

September Term, 1959—January Session, 1960.

No. 12809

CRANE PACKING COMPANY, a corporation, BETH BERNICE GREEN, individually and as Executrix of Earl J. Bullard, Deceased, and RONALD EUGENE GREEN and JANIS LEANORE GREEN, Minors, by Beth Bernice Green, their Next Friend,
Plaintiffs-Appellants,
v.
SPITFIRE TOOL & MACHINE CO., INC., a corporation,
Defendant-Appellee.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

April 1, 1960

Before KNOCH and CASTLE, *Circuit Judges*, and PLATT, *District Judge*.

CASTLE, *Circuit Judge*. Crane Packing Company, a corporation, licensee under Patent Re. 23,937, and Beth Bernice Green (individually, as executrix of the estate of Earl J. Bullard, deceased, and as next friend of Ronald Eugene Green and Janis Leanore Green, minors), plaintiffs-appellants, brought suit against Spitfire Tool & Machine Co., Inc., defendant-appellee, for infringement of claims 1 to 4, inclusive, and 9 to 14, inclusive, of the patent.

Patent Re. 23,937 is a reissue of Patent No. 2,565,590 issued August 28, 1951 to Earl J. Bullard on a grinding and lapping device. It was issued February 8, 1955 on an application filed June 25, 1953.

Defendant's answer included assertions of invalidity of the patent and denial of infringement. The District Court did not reach the issue of infringement but found each of the patent claims in issue invalid and entered judgment for defendant. Plaintiffs appealed contending the court erred in its interpretation of the statutes relating to reissue patents, its interpretation of prior art, its interpretation of the law of aggregation, and in its failure to apply the correct criteria of invention.

A lapping machine is a particular type of fine grinding machine designed and intended to impart to a work piece a finely finished surface. It comprises one or more lapping surfaces, each of which is known as a lap plate, generally made of cast-iron, upon which an abrasive compound is applied. The work piece or article to be lapped is then moved over the surface of the lap plate until the desired surface is obtained on the work piece, or as nearly to the desired surface as the capabilities of the machine permit.

The lapping of an article causes wear and abrasion not only on the surface of the article but also on the surface of the lap plate resulting in its becoming grooved or roughened, and losing its "true" or desired surface. When this occurs the lap surface must be "dressed" or restored to its desired or "true" condition.

The patent in suit discloses maintenance of a true flat surface on the lap plate, or changing it from a convex to a flat, or to a concave surface, and vice-versa. A wear ring (or a plurality thereof) is placed on the surface of an annular lap late having an inner edge around a central cavity, and an outer edge. The wear ring is adapted to hold work pieces which may be placed within the ring in a work holder. A felt pad and a pressure plate are placed over the articles to be lapped. The ring is maintained upon the lap surface by a pivot means or bearings, adjustable so that the ring may be shifted radially on the

surface of the lap plate. As the lap plate is rotated, the frictional relationship between it and the ring causes the latter to rotate but not to travel with the lap since the ring is restrained from such travel by the adjustable pivot or bearings. The ring, therefore, rotates on the lap surface and by friction rotates the work holder and work within the ring. In its rotation on the lap and simultaneous rotation of the lap itself, the ring wears away the surface of the lap and maintains the desired true surface, serving to true the lap and hold the work at the same time. By moving the ring radially so that it overhangs the outer edge or the inner edge of the lap the pressure on portions of the lap surface will be made to vary. As a result a flat, a convex, or a concave surface may be produced or maintained on the lap plate, as desired. And grooves or roughness formed on the plate by pressure of articles against the abrasive material are removed as they form.

Claims 1 to 4, inclusive, and 9 and 10 of Patent Re. 23,937 are all claims of Bullard's 2,565,590 and remain unchanged in the reissue patent. Substantially, they cover an apparatus for forming a true surface of predetermined contour upon an article by grinding or lapping. Claims 11 to 14, inclusive, are added by the reissue. Claims 11 and 12 cover the method of preserving the flatness of a plane surface, or of changing the contour of the surface, of an annular lap to cause it to conform to a standard surface whether such surface be flat, convex or concave. Claims 13 and 14 cover an apparatus for forming a plane surface on an article.

The District Court in its findings of fact and conclusions of law found and concluded, *inter alia*, that claims 1 to 4, inclusive, and 9 and 10 are invalid for lack of invention in view of prior art, and that claims 11 to 14, inclusive, are invalid because the device of these reissue claims was

on sale and in use more than one year prior to June 25, 1953, the date of the application for the reissue patent.

The feature of claims 1 to 4, inclusive, and 9 and 10, relied upon by plaintiffs to distinguish them from prior art and to constitute invention is a ring, resting loosely on and rotated by friction with the lap surface, which in addition to serving as a means to hold articles to be lapped may be utilized to loosely encircle, and rotate by friction, a separate work holder causing the articles to be rotated within the ring. The ring being free to rotate on the lap with a total pressure at least equal to that exerted by the articles lapped and thus by wearing the lap maintains a true lap surface during the lapping operation. The ring may be shifted radially on the lap to grind the lap to either a concave or convex form.

The automatic and continuous maintenance of a true surface serves to eliminate shutdown of the machine for a dressing operation with consequent loss of production, an obvious advantage in mass production industries.

The defendant relies on prior art from which the learned trial judge, on the basis of documentary evidence, exhibits, and the testimony of witnesses, found that it was clear that one having ordinary skill in the art would find the claimed invention obvious. This prior art included Desenberg patent 2,352,146 (1944); Hoke patent 1,536,714 (1925); Morton patent 1,691,120 (1928) and Missler (German) patent 345,443 (1921). All are grinding or lapping devices.

Desenberg discloses a rotatable lap, a work holder for holding the article to be lapped, a ring having a pivoted support and rotating in uniform facial contact with the lap, and by wear operating as a truing tool to automatically maintain the desired lap surface while the article is being lapped. Although the ring of Desenberg does not encircle the work or work holder, Hoke disclosed a work

holder comparable to that of the claims under consideration and plaintiffs' commercial device. Hoke, utilizing opposed annular rotatable laps, discloses a work holder which is caused to rotate within a circular opening in a carrier disk by the rotation and oscillation of the circular carrier between the opposed laps.

Morton discloses a rotatable lap upon which a ring rests loosely and is rotated by friction with the lap surface. In this instance, although the ring is the article being lapped or ground, it is a fundamental principle of the mechanics of the art of lapping, illustrated in plaintiffs' Exhibit No. 14, that the article being lapped wears the surface of the lap. Thus the ring shown and described in Morton illustrated to anyone familiar with the basic mechanics of lapping a ring, resting loosely on and rotated by friction with the lap surface, capable of exerting a wearing action on the lap which may be utilized to automatically and continuously true the lap and maintain the desired surface, *i. e.*, exert corrective action to offset wear, grooving or roughness caused by an article being lapped. The work holder of Hoke when placed in the ring of Morton anticipates the wear ring-work holder combination of the claims in question.

Missler discloses a rotatable lap utilizing a holding or restraining means disposed offset so that the articles being lapped interchangeably pass over the inner and outer rim of the lap in order to insure continuously the evenness of the lap.

It appears from the evidence that customers using plaintiffs' commercial device often omit using the work holder. Some articles may be lapped by being placed within the wear ring without a work holder (and the felt pad and pressure plate used therewith) or by being held on the lap outside of the wear ring, with the same function and result.

The findings and conclusions of the District Court in connection with reissue claims 1 to 4, inclusive, and 9 and 10 are supported by substantial evidence. The feature relied upon by plaintiffs to constitute invention is found in the combination of the truing ring of Desenberg, the loosely resting ring of Morton, the work holder of Hoke and the radial adjustment of Missler. The combination found in the above numbered claims is of elements found and demonstrated in prior art. Their adaption by Bullard resulted in an improvement but represented no more ingenuity than the work of a mechanic skilled in the art. There are no "unusual or surprising consequences from the unification of the elements here concerned" nor did Bullard's use of the features claimed "add to the sum of useful knowledge." *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147. The feature claimed lacks the impalpable something which distinguishes invention from simple mechanical skill.

It is enough to defeat a patent under 35 U.S.C.A. §103 that from one or more related prior art patents, one having ordinary skill in the art would find the claimed invention obvious. *Enterprise Ry. Equipment Co.* v. *Keystone Ry. Equipment Co.*, 7 Cir., 267 F. 2d 102; *Senco Products, Inc.* v. *Fastener Corporation*, 7 Cir., 269 F. 2d 33.

And the presumption of validity arising from the grant of a patent does not exist as against prior art not before the Patent Office. *Hobbs* v. *Wisconsin Power & Light Company*, 7 Cir., 250 F. 2d 100, 105. Of the prior art relied upon by defendant only Desenberg was before the Patent Office.

The District Court applied the correct criteria of invention. It did not err in holding reissue claims 1 to 4, inclusive, and 9 and 10 invalid for lack of invention.

Claims 11 to 14, inclusive, were held invalid under 35

U.S.C.A. §102 (b) because the device was on sale and in use more than one year prior to the filing of the reissue application. The common thread running through claims 11 to 14, inclusive, and contended by plaintiffs to constitute their novel feature, is the "overhanging" rotating wear ring which controls lap contour by overhanging one edge of the annular lap by an amount which takes into consideration the type of article being lapped, and the desired contour. The overhanging ring also smooths out irregularities in the lap and functions as a work holder or to rotate a separate work holder.

Plaintiffs concede that Bullard's commercial device incorporating the overhanging ring feature and embodying the other elements of claims 11 to 14, inclusive, was on sale and in public use in this country more than one year prior to the application for the reissue patent.

35 U.S.C.A. §251 provides for the reissuance of a patent for the invention disclosed in the original patent "Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent * * *" provided that "No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent" and subject to the condition that "The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, * * *". And 35 U.S.C.A. §102 (b) requires denial of an application for a patent if "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States".

The language incorporating provisions of the title re-

lating to applications in the section authorizing and governing reissue patents is an entirely new provision added by the Patent Act of 1952. It was not contained in the previous statute. (R. S. 4916; 35 U.S.C.A. 64). Its scope is not limited to formal or procedural, as distinguished from substantive, matters. We agree with the District Court's conclusion that although a reissue application enlarging claims may be filed within two years from the grant of the original patent it is, nevertheless, subject to the conditions proscribed by §102 (b) which are by reference incorporated in §251. The District Court did not err in holding §102 (b) applicable and that claims 11 to 14, inclusive, were invalid because of public use and sale of Bullard's commercial device more than one year prior to the application for the reissue patent. And such holding is harmonious with the provision of 35 U.S.C.A. §252 that a reissue patent "to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent". Claims 11 to 14, inclusive, are not identical with any claim of the original patent.

The invalidity of all of the patent claims in issue makes irrelevant any consideration of contentions relating to commercial success. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147.

The judgment of the District Court is affirmed.

AFFIRMED.